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Filed : July 14, 2003

REMARKS

The specification is amended to correct typographical informalities. The amendment is made by way of Substitute Specification in accordance with 37 C.F.R. § 1.125. The Substitute Specification includes no new matter.

Claims 8 and 14 are amended herein. Support for the amendment to Claim 8 is found in the specification, for example, at page 10, second full paragraph. Support for the amendment to Claim 14 is found in the specification, for example, at page 5, first full paragraph. The amendments to the claims do not add new matter.

New Claim 21 is supported by the specification, for example, at page 7, first two full paragraphs and Example 1. New Claim 22 is supported by the specification, for example, at page 16, second full paragraph. The new claims do not add new matter.

Upon entry of the amendments, Claims 8, 10-12, 14, 15 and 19-22 are pending. Applicants respectfully request entry of the amendments and reconsideration of the application in view of the following remarks.

Objection to the Specification

The specification is objected to as containing typographical informalities. Enclosed herewith is a Substitute Specification in accordance with 37 C.F.R. § 1.125 in both marked-up and clean copy form. Applicants submit that the Substitute Specification includes no new matter and addresses the objections of the Office Action. Accordingly, Applicants respectfully request removal of the objection to the specification.

Rejection Under 35 U.S.C. §103

Claims 8, 10-12, 14, 15, 19 and 20 are rejected under 35 U.S.C. §103 as being obvious over Sumi (US Pat No 6,582,789) in view of Masuda (U.S. Publication No. 2002/0064650). The Office Action states that Sumi teaches a protective film comprising an adhesive layer on one side of a substrate and an antistatic layer on the other side, and Masuda teaches an antistatic polymer containing pyrrolidinium rings. The Office Action also states that the recited transparency after heat treatment would be inherently present in the combination of the references.

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Applicants submit that Claims 8, 10-12, 14, 15, 19 and 20 are non-obvious over the cited references because the cited references teach away from their combination. Furthermore, Masuda teaches away from the claims.

Sumi and Masuda Teach Away from their Combination

Sumi and Masuda teach away from their combination because Sumi teaches the importance of a surface protective film being highly transparent, and Masuda teaches the criticality of incorporating a dye into the film. In particular, Sumi teaches:

A surface protective film which can be used in the production of components associated with a liquid crystal display such as a polarizer to improve productivity and yields since no air bubbles are trapped when stuck to a substrate having unevenness in the surface and since the adhesion is low and a change of the adhesion with the passage of time is small and which can be *highly transparent* and improve inspectability by using a polyester film having little particles as a base material. *Sumi* at Abstract (emphasis added).

Thus, Sumi teaches the importance of high transparency in Sumi's invention. In contrast, Masuda teaches the importance of incorporating a dye into the film. Specifically, Masuda teaches:

In the biaxially oriented polyester film for window application according to the present invention, *it is essential that a dye be contained in at least one of the coextruded intermediate layers of the laminated film*, and the dye used in the present invention needs to be one which shows absorption in the visible light region (380-780 nm). By containing such a dye, the visible light transmittance of the whole film is controlled to the range of 3 to 70%, preferably 5 to 50%. *Masuda* at paragraph [0019] (emphasis added).

Thus, Masuda teaches that it is critical to Masuda's invention for a dye to be incorporated into the film. If one of ordinary skill were to attempt to maintain the high transparency taught by Sumi, one would avoid incorporating transparency-reducing compounds such as dyes. However, doing so would be contrary to Masuda's teachings. Similarly, if one of ordinary skill were to attempt to reduce visible light transmittance by incorporating a dye, one would go directly contrary to the teachings of Sumi, which emphasizes the criticality a highly transparent film. It is improper to combine references where the references teach away from their combination. *M.P.E.P.* §2145.X.D.2; *see also In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed.

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Cir. 1983). The teachings of Masuda are contrary to the teachings of Sumi. Accordingly, these references teach away from their combination and, thus, are not properly combinable to render the claims obvious.

Masuda Teaches Away from the Claims

The pending claims are further non-obvious over Masuda because Masuda teaches away from the claims. Claim 8, as amended, recites that the transparent surface protective film does not contain a light absorbing compound. Claim 14, as amended, recites that the entirety of the surface protective film is transparent upon visual inspection. As discussed above, Masuda teaches that it is critical to Masuda's invention for a dye to be incorporated into the film. Accordingly, Masuda teaches away from a transparent surface protective film that does not contain a light absorbing compound, as recited in Claim 8. Similarly, Masuda teaches away from a surface protective film that is transparent upon visual inspection, as recited in Claim 14.

A reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *M.P.E.P.* §2141.02.VI; *see also W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." *KSR International Co. v. Teleflex Inc.*, 550 U.S. at ___, 82 USPQ2d at 1395.

Masuda teaches the importance of incorporating a dye into the film. Accordingly, Masuda materially teaches away from the films of Claims 8 and 14. As such, Masuda serves as evidence of the non-obviousness of the claims.

Masuda further Teaches Away from Claims 20 and 21

Masuda further Teaches Away from Claims 20 and 21 because Masuda teaches the importance of a film comprising at least three laminated polyester layers. In particular, Masuda teaches:

The biaxially oriented polyester film according to the present invention is a film *comprising at least three laminated polyester layers*. Masuda at paragraph [0015] (emphasis added).

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Thus, Masuda teaches that it is critical to Masuda's invention the film to comprise at least three laminated polyester layers. As such, Masuda teaches away from a transparent base material film being a single-layer film. Accordingly, Masuda teaches away from the films of Claims 20 and 21.

Rejection Under 35 U.S.C. §103

Claims 8, 10-12, 14, 15 and 20 are rejected under 35 U.S.C. §103 as being obvious over JP 11-256116 in view of Masuda. The Office Action states that JP 11-256116 teaches a protective film comprising an adhesive layer on one side of a substrate and an antistatic layer on the other side, and Masuda teaches an antistatic polymer containing pyrrolidinium rings. The Office Action also states that the recited transparency after heat treatment would be inherently present in the combination of the references.

Applicants submit that Claims 8, 10-12, 14, 15 and 20 are non-obvious over the cited references because the cited references teach away from their combination. Furthermore, Masuda teaches away from the claims.

JP 11-256116 and Masuda Teach Away from their Combination

JP 11-256116 and Masuda teach away from their combination because JP 11-256116 teaches the importance of a surface protective film being highly transparent, and Masuda teaches the criticality of incorporating a dye into the film. In particular, JP 11-256116 teaches:

PROBLEM TO BE SOLVED: To obtain a *transparent* surface-protective film with slight electrification when peeled off, having a combination of anti-staining effect and antistatic effect, by providing one side of a plastic film with a layer containing an antistatic ingredient and anti-staining ingredient and providing the opposite side with a slight-tack layer.

SOLUTION: This surface-protective film is obtained by providing one side of a plastic film (*highly transparent*, e.g. a polyester film such as of polyethylene terephthalate or polyethylene-2,6-naphthalate, also pref. a biaxially oriented film) with a layer containing an antistatic ingredient (e.g. an antistatic agent such as a quaternary ammonium salt) and an anti-staining ingredient (e.g. polyvinyl alcohol) and providing the opposite side with a slight-tack layer. *JP 11-256116* at Abstract (emphasis added).

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Thus, JP 11-256116 teaches the importance of high transparency in the invention. In contrast, Masuda teaches the importance of incorporating a dye into the film. Specifically, Masuda teaches:

In the biaxially oriented polyester film for window application according to the present invention, *it is essential that a dye be contained in at least one of the coextruded intermediate layers of the laminated film*, and the dye used in the present invention needs to be one which shows absorption in the visible light region (380-780 nm). By containing such a dye, the visible light transmittance of the whole film is controlled to the range of 3 to 70%, preferably 5 to 50%. Masuda at paragraph [0019] (emphasis added).

Thus, Masuda teaches that it is critical to Masuda's invention for a dye to be incorporated into the film. If one of ordinary skill were to attempt to maintain the high transparency taught by JP 11-256116, one would avoid incorporating transparency-reducing compounds such as dyes. However, doing so would be contrary to Masuda's teachings. Similarly, if one of ordinary skill were to attempt to reduce visible light transmittance by incorporating a dye, one would go directly contrary to the teachings of JP 11-256116, which emphasizes the criticality a highly transparent film. It is improper to combine references where the references teach away from their combination. *M.P.E.P.* §2145.X.D.2; see also *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The teachings of Masuda are contrary to the teachings of JP 11-256116. Accordingly, these references teach away from their combination and, thus, are not properly combinable to render the claims obvious.

Masuda Teaches Away from the Claims

The pending claims are further non-obvious over Masuda because Masuda teaches away from the claims. Claim 8, as amended, recites that the transparent surface protective film does not contain a light absorbing compound. Claim 14, as amended, recites that the entirety of the surface protective film is transparent upon visual inspection. As discussed above, Masuda teaches that it is critical to Masuda's invention for a dye to be incorporated into the film. Accordingly, Masuda teaches away from a transparent surface protective film that does not contain a light absorbing compound, as recited in Claim 8. Similarly, Masuda teaches away from a surface protective film that is transparent upon visual inspection, as recited in Claim 14.

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A reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *M.P.E.P.* §2141.02.VI; *see also* *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). “When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. at ___, 82 USPQ2d at 1395.

Masuda teaches the importance of incorporating a dye into the film. Accordingly, Masuda materially teaches away from the films of Claims 8 and 14. As such, Masuda serves as evidence of the non-obviousness of the claims.

Masuda further Teaches Away from Claims 20 and 21

Masuda further Teaches Away from Claims 20 and 21 because Masuda teaches the importance of a film comprising at least three laminated polyester layers. In particular, Masuda teaches:

The biaxially oriented polyester film according to the present invention is a film *comprising at least three laminated polyester layers*. Masuda at paragraph [0015] (emphasis added).

Thus, Masuda teaches that it is critical to Masuda’s invention the film to comprise at least three laminated polyester layers. As such, Masuda teaches away from a transparent base material film being a single-layer film. Accordingly, Masuda teaches away from the films of Claims 20 and 21.

Rejection Under 35 U.S.C. §103

Claims 19 is rejected under 35 U.S.C. §103 as being obvious over JP 11-256116 in view of Masuda and Sumi.

Claim 19 depends from Claim 8. As discussed above, both JP 11-256116 and Sumi are not properly combinable with Masuda. Further, Masuda teaches away from Claim 8. For at least these reasons, Claim 19 also is non-obvious over the cited references.

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No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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